



A DOCPHOENIX

APPL PARTS

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OUTGOING

CTMS _____
 Misc. Office Action
1449 _____
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892 _____
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 Abandonment
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File Wrapper

FWCLM _____
 File Wrapper Claim
IIFW _____
 File Wrapper Issue Information
SRFW _____
 File Wrapper Search Info

Internal

SRNT _____
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CLMPTO _____
 PTO Prepared Complete Claim Set

ECBOX _____
 Evidence Copy Box Identification
WCLM _____
 Claim Worksheet
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 Fee Worksheet

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/394,159	09/13/1999	FRED S. MILLER	II-10091	3835

7590 05/20/2003

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EXAMINER

CINTINS. IVARS C

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 05/20/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/394,159

Applicant(s)

Miller et al.

Examiner

Ivars Cintins

Art Unit

1724



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above, claim(s) 13-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12, 21, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). | 6) <input type="checkbox"/> Other: |

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In view of the fact that generic claim 1 is no longer being rejected over any prior art, previously non-elected species claim 22 is hereby rejoined with the elected claims. Claims 13-20 remain withdrawn from consideration, as being directed to a non-elected invention (i.e. method). Applicant should cancel these non-elected method claims in response to this Office action.

Also, in view of Applicant's remarks contained in the response filed February 26, 2003, it is agreed that the limitation contained in the last line of claim 1 is supported by the disclosure originally filed, since the specification states that the "SPME device 40 is mounted to the top of the plunger 52. Accordingly, the new matter rejection contained in the previous Office action is hereby withdrawn. However, the following lack of enablement rejection is deemed to be appropriate.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-12, 21 and 22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most

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nearly connected, to make and/or use the invention. It is not readily apparent that the support structure is capable of being attached to the plunger portion of a syringe, as recited in the last line of claim 1. As shown in Fig. 4, the only figure showing an embodiment which includes a syringe, the SPME device 40 is enclosed in a metal sleeve 60, which metal sleeve extends through the plunger 52, and appears to terminate at the handle 54. Accordingly, it is not seen how the support structure 44, enclosed within this metal sleeve, can be "attached to the plunger" since metal sleeve 60 appears to prevent this support structure from ever coming in contact with the plunger.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-12, 21 and 22 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. These claims appear to be misdescriptive, since it is not readily apparent that the support structure is capable of being attached to the plunger portion of a syringe, as recited in the last line of claim 1, for the reasons given above.